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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,079	12/12/2001	Yutaka Hasegawa	SUZU:002	6932

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EXAMINER	
BOVEJA, NAMRATA	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/016,079	HASEGAWA, YUTAKA	
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 06/12/2006.

2. Claims 1-16 are presented for examination.

3. Amendments to claims 1-16 have been entered and considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. *Claims 1-16, are rejected under 103(a) as being anticipated by Yamanaka et al. (Publication Number US 2001/0016834 A1 hereinafter Yamanaka) in view of Official Notice.*

In reference to claims 1, 5, 9, and 13, Yamanaka discloses the method, system, a machine-readable medium, and a computer program for managing an information service, which handles *contribution and* distribution of digital contents and presentation of advertising messages to users *of the information service via plurality of user terminals* over a computer network (abstract and page 1 paragraphs 12-16), the system comprising: a first database containing advertising messages provided from advertisers (page 1 paragraph 16, page 6 paragraph 117, page 10 paragraph 181, page 15 paragraphs 258, 263, and 264, page 16 paragraphs 271-273, and Figures 4, 5, 14, 15,

23, and 27) *that* subscribe *to* the information service with payment of advertisement fees (page 1 paragraph 17, page 2 paragraph 25, page 9 paragraph 153, page 11 paragraph 184, and page 12 paragraph 198); a second database containing a plurality of digital contents which are subject to legal protection on behalf of content proprietors (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28); a presenting section that presents the advertising messages over the computer network to the users *via the plurality of user terminals* (page 7 paragraph 119, page 9 paragraph 162, page 15 paragraphs 263 and 264, page 16 paragraphs 271-276, and Figures 7 and 8)*;* a distributing section that distributes the *registered* digital content to *another of user via another of the user terminals* upon request from the *another* user over the computer network (page 6 paragraph 118 to page 7 paragraph 119, page 8 paragraph 134, page 9 paragraph 152, page 15 paragraphs 261-262, and page 16 paragraph 284); and an allocating section that allocates at least a part of the advertisement fees collected from the subscribing advertisers to the content proprietor of the *registered* digital content identified in the status information (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraph 142, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20); *a contributing section that contributes digital content from one of the users via a user terminal wherein the users are different from the identified content proprietors (page 8 paragraphs 138 and 139, page 11 paragraph 190, page 20 paragraph 343, and Figure 15).*

Yamanaka is silent about contributing digital content with status information indicting that the contributed digital content is subject to the legal protection and identifying a content proprietor of the contributed digital content, which is created as a secondary work by the one user, who is different from the identified content proprietor, and a registering section that registers the contributed digital content into the second database together with the status information. Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner. Furthermore, it would have been obvious to do this in order to ensure payment to the content holder by the distributor as indicated by the data presented from the execution key associated with a particular content holder for the number of times the content was executed by a user can be made quickly and accurately.

5. In reference to claims 2, 6, 10, and 14, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains protected digital contents subject to legal protection (i.e. content owned by

creators and holders excluding distributors that requires the use of an execution key) and non-protected digital contents not subject to legal protection (i.e. content owned by distributors that also may not required the use of an execution key) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28), such that the allocating section allocates the collected advertisement fees to the proprietors (i.e. content creators and holders excluding distributors based on the number of times the content was executed as tracked by the execution key) only when the protected digital contents are distributed to the users *via the user terminals* (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

6. In reference to claims 4, 8, 12, and 16, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains a multiple of digital contents subject to legal protection on behalf of the same proprietors (i.e. multiple songs by the same artists or from the same CD for which creators and holders own the rights, multiple game titles by the same manufacturer of the game CD's, and multiple movies by the same movie director) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 7 paragraph 126, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 7, 8, 23, 27, and 28) such that the allocating section allocates a part of the collected advertisement fees to the same proprietor when any of the multiple of the

digital contents is distributed to the users *via the user terminals* (i.e. pay the proprietors according to each song download on a per song basis regardless if more than one song from the same artist is downloaded or even if the same song is downloaded more than once) (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 7 paragraph 131, page 8 paragraphs 142-143, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

7. In reference to claims 3, 7, 11, and 15, Yamanaka discloses *a system, method, a machine readable medium, and computer-readable storage device wherein the* allocating *section allocates the* collected advertisement fees only *if* registered (i.e. accepted or obtained or under contractual agreement) (page 4 paragraph 67) *digital* content *is distributed* under the legal protection (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

Yamanaka doesn't specifically teach the use of status information (i.e. presence information for indicating contents subject or not subject to legal protection) indicating whether or not the contributed digital contents are subject to the legal protection. Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner.

Response to Arguments

8. After careful review of Applicant's remarks/arguments filed on 06/12/2006, the examiner fully considered the arguments, but they are not persuasive. Amendments to the claims have been entered and considered.

9. In reference to claims 3, 7, 11, and 15, Applicant argues Yamanaka does not disclose submitting digital contents by users of the service who are different from the proprietors and that Yamanaka does not teach a system where the users can legally contribute digital content owned by others.

The Examiner respectfully disagrees with Applicant, because Yamanaka clearly teaches submitting digital contents by users of the service who are different from the proprietors by disclosing that an agent of a creator or a person who obtains a permission from the creator can submit digital content (page 8 paragraph 139) and a system where the users can legally contribute content owned by others, since the creator can grant digital content rights to agents or others and may desire to make a contract with distributors and administrators (page 8 paragraph 137 and Figure 1).

Furthermore, with regard to the Examiner's use of Official Notice, the Applicant states, "even if what the Examiner alleges were to be correct, for argument's sake." With respect to this, the Examiner would like to point out that the Applicant has not

presented arguments that the features are not well known. The Applicant's only argument has been, "even if what the Examiner alleges were to be correct", for argument's sake. This does not constitute a proper challenge to the Official Notice. Per the MPEP 2144.03, "A seasonable challenge constitutes a demand for evidence be made as soon as practicable during prosecution. Thus the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." The Applicant has not submitted any rebuttal of the well-known statements, but has merely stated that "even if what the Examiner alleges were to be correct". In the paragraph in MPEP 2144.03 immediately preceding the above citing, reference is made to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations." Again, the Applicant has not challenged the correctness of the assertions. Bald statements such as "even if what the Examiner alleges were to be correct", are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on part of the Examiner to use it in the process of establishing a rejection of notoriously well-known facts (*In re Boon*, 169 USP 231 (CCPA 1971)).

10. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office Action. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

N.B.

August 17th, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER